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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,844	11/19/2001	Mark David Siegel	23679-7005	4461
7590	08/01/2006		EXAMINER	
MCCUTCHEN, DOYLE, BROWN & ENERSEN Suite 1800 Three Embarcadero Center San Francisco, CA 94111-4067			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/042,844	SIEGEL ET AL.
	Examiner	Art Unit
	Corbett B. Coburn	3714

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 May 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 and 23-44 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 and 23-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 2 May 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Number 6,709,336 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 states, “the game data can include character data...” It does not affirmatively claim that it does include character data. This renders the claims indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 14, 15 & 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (JP 2000308,763) in view of Diablo (Blizzard Entertainment, 30 November 1996).

Claim 1: Ebisawa teaches a gaming device (32) with a scanner (40) for scanning a barcode corresponding to a product identification (paragraph 0001). There is a processing means (38) for receiving the barcode from the scanner. The processor translates the barcode into game data and determines whether the game data are compatible game data. There is a storage medium for storing the compatible game data. (0009) Ebisawa does not teach the division of characters into groups where members of the group do not attack each other. This is extremely common in the art. Diablo is merely one example. In Diablo, monsters (one group) do not attack each other – they only attack player characters (a second group). Basically, this is how adventure games work. The player kills the monsters and the monsters try to kill the players. Monsters don't kill other monsters because that would rob the player of the fun of doing so. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ebisawa in view of Diablo to divide the characters into groups whose members do not attack fellow group members in order to implement an adventure game where players get the enjoyment of killing monsters.

Claim 2: Diablo teaches item data (i.e., magical items) where at least one player can use the item.

Claim 3: The gaming device is a handheld gaming device. (Figs 4 & 9)

Claim 4: The scanner (40) inherently has a light-emitting diode.

Claim 5: There is a screen (25 or 44) for displaying a menu (Fig 6 & 0118) according to signals from the processor (38).

Claim 6: The storage medium includes a look-up table (“stock information”) to which the processor (40) refers when it translates the barcode into game data. The look-up table correlates a plurality of different barcodes to a plurality of different game data. (0013-0018 & 0059-0060)

Claims 7-10: Ebisawa teaches reading barcodes but does not teach European Article Numbering code, Universal Product Code, Global Trade Item Number code and Global Location Number code, are all equivalent types of barcodes and are disclosed as such by Applicant. They are equivalent to the JAN disclosed by Ebisawa. (0052) They are used to mark products in different parts of the world. For instance, the EAN is preferred for use in Europe. The UPC is used in the United States. It would have been obvious to one of ordinary skill in the art to have used one (or all) of the above mentioned barcode formats to allow players in different parts of the world to use the invention.

Claim 11: Ebisawa’s gaming device includes a speaker. (26 & paragraph 0046)

Claims 12, 14 & 15: Ebisawa teaches that the processing means determines when the game data are incompatible game data (i.e., data corresponding to enemy characters) (0035 & 0061) and determines whether a contest (a battle) will be staged on the screen based on that determination (i.e., waging-war mold [sic]). (0073)

Claims 30-34: Ebisawa teaches a barcode on an arbitrary household product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56) The barcode is translated into gaming data related to the gaming device.

6. Claims 13, 16, 17, 23-29 & 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa & Diablo as applied to claim 1 or 12 in view of Ng (US Patent Number 5,971,855).

Claims 13 & 16: Ebisawa & Diablo teach the invention substantially as claimed, including graphically displaying a battle between characters represented by compatible and incompatible data. Ebisawa appears to teach linking gaming machines via a communications port (Fig 10), but due to the poor quality of the machine translation, Examiner cannot be certain. Ng clearly teaches to teach linking gaming machines via a communications port (Fig 1A & Abstract) in order to facilitate play between two players. This increases the enjoyment to be had from the gaming device. (Col 2, 57-60) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ebisawa in view of Ng to link gaming machines via a communications port in order to facilitate play between two players, thus increasing the enjoyment to be had from the gaming device.

Claims 17, 24: Ng's communication port has a first tab for fitting into a first slot of the second gaming device and a second slot for receiving a second tab of the second gaming device (Fig 1A) and a plurality of contacts for transmitting data between the two gaming devices. (Col 3, 15 & 16)

Claim 23: Claim 23 is a combination of claims 1-4 & 16, which see.

Claims 25 & 26: The physical shape and color of the case (i.e., in the form of a logo associated with and a color associated with the game data) are a matter of aesthetic

design choice. A red case is not patentably distinct from a blue case, nor is one with a particular logo patentably distinct from a case with another logo.

Claim 27: Both Ebisawa and Ng have screens and buttons on one side of the case.

Ebisawa teaches the display of menus (Fig 6) and by necessity selecting choices from the menu using the control buttons.

Claim 28: Ng's coupling device is disposed on a first side of the case. (Fig 1A)

Claim 29: Claim 29 is a combination of claims 1, 2, 6, 8, & 16, which see.

Claims 35-39: Ebisawa teaches a barcode on an arbitrary product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56)

Claims 40-44: Ebisawa teaches the use of JAN instead of UPC. As discussed above in connection with claims 7-10, JAN and UPC are obvious equivalents.

Response to Arguments

7. Applicant's arguments with respect to claims 1-17 & 23-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

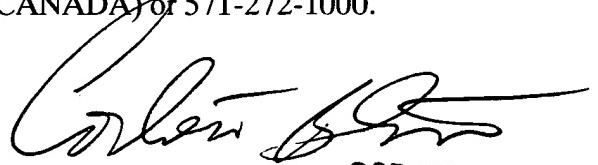
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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CORBETT B. COBURN
PRIMARY EXAMINER